

REMARKS

Claims 1-27 are pending. Applicant thanks the Examiner for her indication that claims 21-27 are in allowable form. Claims 1-3 were rejected under 35 U.S.C. § 102(b) as anticipated by Sun (U.S. Patent No. 6,129,745, "Sun"). Claim 14 was rejected under 35 U.S.C. § 102(b) as anticipated by Hill (U.S. Patent No. 6,195,584, "Hill"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being rendered obvious by Sun in view of Hill. Applicant respectfully traverses the grounds for Examiner's rejections listed below.

I. Claim rejections under 35 U.S.C. § 102

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sun (U.S. Patent No. 6,129,745) and claim 14 was rejected under 35 U.S.C. § 102(b) as being anticipated by Hill (U.S. Patent No. 6,195,584). Applicant respectfully traverses the ground for these rejections.

"[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Techs., Ltd. v. Rockwell Int'l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for "anticipation," is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). Independent claims 1 and 14 were further amended and clarified to include a "means for preventing switching to a DDD pacing mode when a condition indicative of a suspected loss of atrial detection is detected." Applicant respectfully believes that this means limitation is not an "intent to use" but rather specific functionality that is programmed into the implantable device that is not found in any other prior art device capable of automatic mode commutation operation.

Both Sun and Hill disclose well known mode operations that fail to disclose the Applicant's claimed functionality. For example, Sun discloses the typical functionality of delivering a ventricular pulse when a V-V escape interval times out. Hill discloses a method and apparatus for determining atrial lead location and only tangentially mentions applying timers for calculating escape intervals. Neither of these references, when considered alone or in combination, discloses, for example, functionality for *preventing* mode switching when a condition, such as a ventricular extrasystole, is detected. Indeed, if anything, both Sun and Hill teach to apply therapy in the event that cardiac conditions are detected. *See* Sun, Col. 6, Lns. 42-44 ("However, in this case [referring to Fig. 1(b)], there is no intervening V sense, so upon time-out of the V-V escape interval, a VP [ventricular pulse] is delivered."). *See also* Hill, Col. 9, Lns. 4-6 ("In the event that an atrial or ventricular tachycardia is so determined, and an antitachycardia pacing regimen is programmed...."). Indeed, as both references indicate, they essentially teach to switch to a DDD pacing mode in the event that a cardiac condition, like a ventricular extrasystole, is detected.

For this reason, Applicant respectfully asks that the Examiner withdraw the grounds for these rejections.

V. 35 U.S.C. § 103(a) Rejections

Claim 8, which is dependent to independent claim 1 through claim 2, was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sun in view of Hill. Applicant respectfully traverses the grounds for this rejection in view of the above amendments to the claims and the following remarks.

The recent Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) has done away with the rigid "teaching, suggestion, or motivation test" traditionally relied on to establish a *Prima Facie* case of obviousness. Instead of this rigid test, the Court has offered a "common sense" approach to making determinations of obviousness, stating that an initial inquiry should be "whether the improvement is more than just a predictable use of the prior-art elements according to their established functions." See *KSR Int'l*, slip op. at p. 4. The Court also acknowledged that it is equally important to determine if there is an "apparent reason" to combine the references based on their "interrelated teachings." *Id.* Finally, the Court also impliedly recognized that the prior art references, when combined, still must disclose all of the elements of the invention at issue for obviousness to be found. *Id.* at pp. 4-5.

Independent claim 1 was further amended and clarified to include a "means for preventing switching to a DDD pacing mode when a condition indicative of a suspected loss of atrial detection is detected." As discussed above with respect to claims 1 and 14, neither Sun nor Hill disclose any functionality to prevent switching to a DDD pacing mode in the event that such cardiac conditions are detected. Thus, even if there was a reason for one of ordinary skill in the art to combine these two references, the combination would fail to disclose each and every element found in claim 8 and independent claim 1.

Moreover, notwithstanding the holding in *KSR*, it is significant that Sun and Hill teach away from preventing switching to a DDD pacing mode when any of the taught cardiac conditions are detected. See *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997) (holding that a *prima facie* case of obviousness may also be rebutted by a showing that the art, in any material respect, teaches away from the claimed invention). See also MPEP, 8th Ed., at 2144.05. As

discussed above with respect to claims 1 and 14, both Sun and Hill both teach to apply a therapy (necessitating a switch a DDD pacing mode) immediately to treat these kinds of cardiac conditions.

For the foregoing reasons, Applicant believes Claim 8 is now in condition for allowance.

CONCLUSION

Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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